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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/392,247	02/22/95	BERDUT	E BER-005/CIP

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EXAMINER	
MORANO IV,S	

ART UNIT	PAPER NUMBER
3103	6

DATE MAILED: 04/05/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/392,247	Applicant(s) Berdut
	Examiner S. Joseph Morano	Group Art Unit 3103

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Applicant is advised that the formal drawings filed 4/5/95 have been received, and have been forwarded to the draftsman for further review.

2. Applicant is requested to supply the date of publication (if known) of the ceramic magnets order sheet cited on the PTO form 1449, so that the entry can be properly printed on the patent face. This reference has been considered by the examiner as prior art.

3. Correction of the following formalities is required:

1) On line 28 of claim 1, "magnetics" should read --magnets--.

2) On line 1 of claim 11, --a-- should be inserted before "train".

3) On line 12 of claim 11, "and" should be deleted.

4) On line 1 of claim 15, "levitations" should be changed to --levitation--.

4. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-11 and 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending application Serial No. 08/398,171 in view of Minovitch.

The claims of the co-pending application show all of the features claimed, except for the use of its advantageous magnetic unit in a train application. The Minovitch reference shows the use of levitated train systems, to be a well known and suitable type of alternate equivalent application in the art for the advantageous magnetic force transmission unit of the co-pending application. It would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the claims of the co-pending application to include the use of its advantageous magnetic unit in a levitation train application, as taught by Minovitch, as this would have been considered an obvious alternative application and use for the magnetic unit of co-pending application, in a related field of endeavor, as demonstrated by Minovitch; thereby increasing the versatility and marketability of the device.

This is a *provisional* obviousness-type double patenting rejection.

6. Claims 1-14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, on line 22 of claim 1, "a magnetic unit" is confusing, as it is unclear how this is related to the previously recited "magnetic unit" above. It is suggested that inserting --said-- after "a" should correct this problem. On lines 29-30 of claim 1, the entire phrase "an opposite pole. . .magnet" is extremely confusing, as it is unclear what feature of the invention applicant is attempting to claim through the use of this awkward phraseology. It is believed that some text may be missing from this phrase. Clarification is required. On line 2 of claim 2, "a malleable steel member" is confusing, as it is unclear how this is related to the previous "member" recited above. It is suggested that inserting --the permeable members are-- before "a" should correct this problem. On line 5 of claim 3, "said vehicle" lacks proper antecedent basis. It is suggested that replacing "said" with --a-- should correct this problem. On line 3 of claim 4, line 6 of claim 4, and line 3 of claim 5, "said permanent magnet members" lacks proper antecedent basis.

It is suggested that changing this phase to read --said permanent magnets-- should correct this problem. On line 3 of claim 6, "said magnetic members" lacks proper antecedent basis. It is suggested that changing this phase to read --said permanent magnets-- should correct this problem. On line 3 of claim 8, "said magnetic units" lacks proper antecedent basis, since only a single unit has been previously recited. It is suggested that changing this phrase to read --said pairs of said groups-- should correct this problem. On line 4 of claim 10, ", such as a train," is confusing, as this expression is an improper range within a range, and it is unclear from the term "such as" whether applicant is attempting to claim this feature or not. It is suggested that deleting this phrase should correct this problem. On lines 4-5 of claim 12, "said plurality of permanent magnetic units" lacks proper antecedent basis. It is suggested that changing this phrase to --said permanent magnets-- should correct this problem. It is suggested that deleting this phrase should correct this problem. On lines 9-10 of claim 12, "said permanent magnetic units" lacks proper antecedent basis. It is suggested that changing this phrase to --said permanent magnets-- should correct this problem. On line 13 of claim 12, "said hydraulic means" lacks proper antecedent basis. It is suggested that changing "said" to --a-- should correct this problem. Claim 11 is confusing as a whole, as from the preamble of the claims,

applicant is claiming only the subcombination of "A suspension system for...a train" (emphasis added), but in the body of the claim is introducing limitations to, and/or structural connections between, the combination of the system and the train, rendering the scope of the claims unclear, as it is unclear from the context of the claims if applicant is claiming just the system or the system and train combination. If applicant intends to only claim the subcombination, then the structure of or structural connections to the train should not be positively recited in the claims, and should only be referred to in purely functional or intended use format. It is suggested that inserting --for-- before "forming" on line 3 should correct this problem.

7. Claims 1-15 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112.

8. Schuster is cited as an example in the art of a magnetic unit for magnetic force transmission members.

9. Any inquiry concerning this communication should be directed to S. Joseph Morano at telephone number (703) 308-0230. Examiner Morano can normally be reached Monday through Thursday, 6:30am-5:00pm.

sjm
March 30, 1996

S. JOSEPH MORANO
PATENT EXAMINER
GROUP 310